<u>REMARKS</u>

Claims 1-4, 6-24 and 26-32 are currently pending in the subject application and are presently under consideration. Claims 1, 3, 6-9, 23, 24, 26, 27 and 29-32 have been amended as shown on pp. 2-7 of the Reply. Additionally, claims 5 and 25 have been canceled and the limitations have been incorporated into independent claims 1 and 24 respectively. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   <u>Rejection of Claims 1, 15, 20, 21, 23, 24 and 32 Under 35 U.S.C. §112</u>

Claims 1, 15, 20, 21, 23, 24 and 32 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection should be withdrawn for at least the following reasons. One skilled in the art would understand what is claimed when the claims are read in light of the specification.

> The test for definiteness under 35 U.S.C. §112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 U.S.P.Q.2d 1081, 1088 (Fed. Cir. 1986). *See* MPEP 2173.03.

In regard to claim 1, it is contended in the subject Office Action that it is unclear as to what is meant by desired code functionality as recited by independent claim 1. Independent claim 1, as amended, recites, in pertinent part, *a discovery component that receives data relating to a request for at least one of a desired functionality of the programming code and one or more desired documents*. The specification discloses that a user may *desire* to know what *functionality* is required to implement an object function or method, such as late-bound function calls, in a *programming language* that the user has not experienced before. (*See* pg. 8, ll. 4-7 and pg. 10, ll. 5-8). Thus, desired functionality of the programming code is the task the user wants to accomplish with the programming language code in question. Accordingly, one skilled in the art would understand what is claimed when claim 1 is read in light of the specification.

Regarding claim 15, the Examiner contends that it is unclear as to what is meant by a technical value. The meaning and function of the technical value is explained in the specification. For instance, according to the specification, a database of search attempts can be created wherein technical information is weighted according to its respective value to those who have previously sought similar types of information. The weighted information can be an indicator of technical value for selected technical information so that developers can easily and quickly gauge potential effectiveness of accessing a selected document. (*See* pg. 4, ll. 9, 15 and Fig. 4). Moreover, the specification discloses that the weighting of information that indicates technical value can be achieved by automatically monitoring visible technical documentation, associated search engine activity, network traffic activity or by ranking input from a user. (*See* pg. 4, ll. 16-23 and Fig. 4). Thus, technical value is the significance, effectiveness, usefulness or quality of selected technical information from a documentation set and is determined by automatic measurements and explicit user input. Accordingly, one skilled in the art would understand what is claimed when claim 15 is read in light of the specification.

In regard to claims 20 and 21, it is contended in the subject Office Action that it is unclear as to what is meant by developer terms. Applicant's representative respectfully disagrees with such contention. The specification discloses that developer terms are words and phrases commonly employed by software developers. (*See* pg. 12, line 26 – pg. 15, line 8 and Fig. 6). Thus, developer terms are those used by developers as opposed to another system of terms such as industry standard terms or terms used by an author of technical documentation. Therefore, one skilled in the art would understand what is claimed when claims 20 and 21 are read in light of the specification.

Regarding claims 23, 24 and 32, it is contended that is unclear as to what is meant by familiar, unfamiliar, and functional information. Claims 23, 24 and 32 have been amended to make definite what is being claimed and, in light of these amendments, it is respectfully requested that the rejection of claims 23, 24 and 32 be withdrawn.

For at least the foregoing reasons, one skilled in the art would understand what is being claimed when claims 1, 15, 20, 21, 23, 24 and 32 are read in light of specification. Therefore, this rejection should be withdrawn.

II.   Rejection of Claims 1, 2, 4, 11, 12, 20-24, 26-29, 31 and 32 Under 35 U.S.C. §102(e)

Claims 1, 2, 4, 11, 12, 20-24, 26-29, 31 and 32 stand rejected under 35 U.S.C. §102(e) as being anticipated by Harris (U.S. 2002/0059204). This rejection should be withdrawn for at least the following reasons. Harris does not disclose, teach or suggest each and every limitation of the subject claims.

> For a prior art reference to anticipate, 35 U.S.C. §102 requires that *"each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

The subject invention relates to systems and methods that facilitate automated discovery of information. A software developer can discover and interpret technology-specific and programming-language-specific functionality utilizing natural and professional languages that may be independent of that employed by the author of the associated technical documentation describing such functionality. (*See* Summary).

In particular, independent claim 1 (and similarly independent claims 23, 24, 31 and 32) recites *a system that facilitates generation of code and/or documents comprising a discovery component that receives data relating to a request for at least one of a desired functionality of the programming code and one or more desired documents, a mapping component that correlates parsed subsets of the data to specific functional objects, **the functional objects represent vocabulary and terminology modeled or learned from at least one user's past patterns when searching for or seeking information** and a generator that employs the functional objects to form at least one of the desired functionality of the programming code and the documents.* Harris does not disclose, teach or suggest such novel aspects.

Rather, Harris relates to a system and method for distributing a query to devices on a communications network using an application that can survey a subscriber's server and use the formatting information and data from the survey to create a dictionary customized to the subscriber's data sources. The dictionary can customize a natural language query to a precise SQL query applicable to the subscriber's data source. (*See* Abstract and Summary). The

dictionary performs linguistic processing on a natural language query (*e.g.* context analysis, synonym generation) and matches the natural language query to the survey to produce the customized SQL query. (*See* paragraphs 43 and 46). Further, the survey engine can create the dictionary by identifying the labels of tables, rows and columns of a database data source so that dictionary can translate the natural language query by utilizing the terminology derived from the survey engine. *(See* paragraph 44). Thus, while Harris discloses translating the natural language input from a user to a customized SQL server, the translation is performed by matching the input to database schema information identified by the survey engine and is not correlated to functional objects that represent vocabulary and terminology modeled or learned from at least one user's past patterns when searching for or seeking information as recited in the subject claims. Therefore, Harris does not disclose each and every limitation recited by the claimed invention.

In view of at least the foregoing, it is respectfully submitted that Harris does not disclose, teach or suggest applicant's claimed invention as recited in independent claims 1, 23, 24, 31 and 32 (and the subsequent dependent claims which depend there from). Accordingly, this rejection should be withdrawn and the claims allowed.

III.   Rejection of Claims 3, 5-10, 13-19, 25 and 30 Under 35 U.S.C. §103(a)

Claims 3, 5-10, 13-19, 25 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Harris in view of Herz (U.S. 6,029,195). This rejection should be withdrawn for at least the following reasons. Harris and Herz, considered individually or in combination, do not teach or suggest each and every limitation of the subject claims.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. *See* MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of

success ***must be found in the prior art and not based on the Applicant's disclosure.*** *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993).

Claims 3, 5-10 and 13-19 depend from independent claim 1 and claims 25 and 30 depend from independent claim 24. Claims 5 and 25 have been canceled and the limitations recited therein have been incorporated into independent claims 1 and 24 respectively.

Accordingly, independent claim 1 (and similarly, independent claims 23, 24, 31 and 32) recites *a system that facilitates generation of code and/or documents comprising a discovery component that receives data relating to a request for at least one of a desired functionality of the programming code and one or more desired documents, a mapping component that correlates parsed subsets of the data to specific functional objects,* ***the functional objects represent vocabulary and terminology modeled or learned from at least one user's past patterns when searching for or seeking information*** *and a generator that employs the functional objects to form at least one of the desired functionality of the programming code and the documents.* The cited references fail to teach or suggest such claimed aspects.

As mentioned *supra* and admitted in the subject Office Action, Harris does not teach or suggest functional objects that represent vocabulary and terminology modeled or learned from at least one user's past patterns as recited in the subject claims. However, it is asserted that Herz makes up for the deficiencies of Harris. Applicant's representative respectfully disagrees with such assertion.

Rather, Herz relates to a customized electronic identification of desirable objects in an electronic media environment. The system automatically constructs a target profile for each target object in the electronic media based on the frequency with which each word appears in an article relative to its overall frequency of use in all articles. A target profile interest summary for each user is created to describe the user's interest level in various types of target objects. The system evaluates the target profiles against the users' target profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to

each user. (*See* Abstract). The activity of the user is monitored to judge relevance of interest. For example, Herz tracks which articles are read and how long the user reads the article. This information is utilized to determine the interest of the user for the target profile interest summary. (*See* col. 18, ll. 25-40 and col. 65, ll. 50-67). Activity monitoring is utilized to determine a user's potential level of interest in an article and not to model functional objects that represent familiar vocabulary and terminology as recited by the claimed invention. Thus, Herz relates to a system that ranks articles available on an electronic media according to a user's potential level of interest in each article and is silent regarding correlating a user request data to functional objects that represent vocabulary and terminology modeled or learned from at least one user's past patterns as recited in the subject claims.

Moreover, the Federal Circuit has consistently held that in order to establish obviousness *vis-à-vis* a combination of cited references, the cited references *must themselves provide a suggestion for the combination* to one of ordinary skill in the art. The suggestion for such a combination cannot and must not be based on applicant's disclosure using hindsight. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In general, the rationale proffered to combine such teachings is to achieve benefits identified in applicant's specification. Applicant's representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages provided in applicant's specification. This sort of rationale has been condemned by the CAFC.

Still further yet, assuming *arguendo* that the cited references were combinable, the claimed invention would not result. If anything, the combination of references would teach a modification of the way results are in returned in Harris. More particularly, such a combination would teach a system where the results to a natural language query would be presented in a user-customized rank ordered listing based upon the evaluation of the query results and the interest level of the user. The references simply fail to teach or suggest the claimed combination of features. Hence, it is submitted that the interpretation of the references has been altered by improper hindsight and a desire to depreciate features of the claimed innovation.

In view of the foregoing comments, it is readily apparent that Harris, considered individually or in combination with Herz, does not make obvious applicant's invention as recited in the subject claims. Accordingly, the rejection of these claims should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP491US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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